



Paper No. 6

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OFFICE OF PETITIONS

In re Application of :
Zachary Gibler, Timothy Hogan, :
Patrick Quinn, Charles Darnell and : DECISION REFUSING STATUS
Doug Stang : UNDER 37 C.F.R. §1.47(a)
Application No. 10/005,099 :
Filed: December 5, 2001 :
Attorney Docket No. N0023/250365 :
Title: SYSTEMS AND METHODS FOR :
PROVIDING LIGHTING SOLUTIONS OVER A :
COMPUTER NETWORK :

This is a decision on the "Response to Notice to File Missing Parts of Application and Petition under 37 CFR 1.47(a)," filed July 8, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on December 5, 2001, with an unexecuted declaration. Zachary Gibler, Timothy Hogan, Patrick Quinn, Charles Darnell and Doug Stang were named as joint inventors. Accordingly, on January 7, 2002, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply, with extensions of time obtainable under § 1.136(a).

In response, applicants filed the instant petition, with a declaration executed by joint inventors Gibler, Hogan, Quinn and Darnell on behalf of themselves and on behalf of non-signing joint inventor Stang; and paid both the petition fee and late surcharge. This reply was made timely by an accompanying petition for extension of time for response within the fourth month (and fee). Applicants assert that status under § 1.47 is proper because inventor Stang has not responded to a presentation of the declaration at one address, and cannot be found at a more recent address. In support thereof, applicants submitted the declaration of associate counsel Karen Shelton.

A grantable petition under 37 CFR § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1), and possibly (4).

The evidence does not show that inventor Stang has refused to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence currently of record only supports a conclusion that the combined declaration and power of attorney and assignment papers were presented to inventor Stang. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)..

Nor have applicants submitted adequate proof of their inability to reach or find non-signing inventor Stang after diligent effort. Attorney Shelton's declaration shows that after no response was received to the presentation of the declaration at one address, further investigation was undertaken and a new address was uncovered. However, the mailing to inventor Stang at that address went "unclaimed." This evidence is not adequate to show diligent efforts to reach or find inventor Stang. Having been unsuccessful in contacting inventor Stang at a no longer valid address, there is no indication that Rule 47 applicants attempted to determine inventor Stang's forwarding address, and to send the application papers to that address for consideration by inventor Stang. See MPEP 409.03(d). If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, a new telephone number, or the Internet continue to fail, then applicants will have provided the necessary proof required under 37 CFR 1.47 that the inventor cannot be reached or found after diligent effort. Details of the efforts to locate non-signing inventor Stang should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicants should also submit documentary evidence such as the results of an E-mail or Internet search.

Given the further efforts that should be undertaken to locate inventor Stang, any renewed petition should include any new last known address of non-signing inventor Stang.

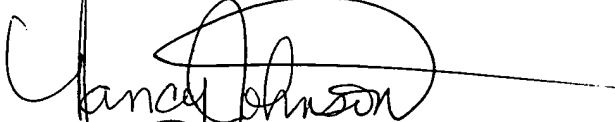
Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a long horizontal line extending to the right.

Nancy Johnson
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Office of the Deputy Commissioner
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